

REMARKS

Claims 1, 2, 7-11, 14, 19-23, and 28-37 stand rejected. With this amendment, claim 36 is cancelled. Independent claims 1, 9, and 20 have been amended to more clearly illustrate that the two-dimensional bar code encoding previously provided biometric information is electronically transmitted to an intended recipient of an ordered package.

Independent claims 1, 9, 20 and certain claims depending therefrom are rejected under 35 U.S.C. § 103(a) as being unpatentable over International Publication No. WO 96/03286 (“*Priddy*”) in view of U.S. Patent No. 5,869,819 (“*Knowles*”). Applicant respectfully traverses the Office’s § 103 rejections of the independent claims. Applicant submits that, contrary to MPEP § 2143, the Office has failed to make out a *prima facie* case of obviousness in that the Office has (1) failed to cite references that teach or suggest all of the elements recited in the rejected claims; (2) failed to show or cite where in the prior art there is a suggestion or motivation to combine the references; (3) failed to show or cite where in the prior art there exists a reasonable expectation of success if the proposed combination was made.

As already indicated, independent claims 1, 9, and 20 have been amended to more clearly illustrate that the two-dimensional bar code encoding previously provided biometric information is electronically transmitted to the intended recipient of an ordered package. Contrary to Applicant’s invention, *Priddy* teaches a “self-verifying” mechanism in which a “machine-readable data set” is “fixed” to the article. *Priddy*, p. 4, lines 17-20. *See also Priddy*, p. 12, lines 9-11. The machine-readable data set travels with the article and is matched at some point to a second data set either also attached to the article or obtained from the bearer of the article.

Priddy, p. 14, lines 17-34. The article is deemed authenticated if a match exists between the first and second data sets. **Priddy**, p. 20, lines 3-10.

The Office correctly notes that **Priddy** does not disclose electronically transmitting the two-dimensional bar code to the intended recipient of a package; a feature recited in the amended independent claims (1, 9, and 20) of the present application. Office Action, p. 10 (rejection for claim 20). The Office cites instead to **Knowles** for this missing element. **Knowles**, however, does not teach or suggest electronically transmitting a two-dimensional bar code to the intended recipient of a package. Figure 8 of **Knowles** - relied on by the Office - illustrates an encoded URL that identifies a particular website address that is accessible via the Internet. (17:16-31). Figure 8 relates to the "Internet Scanning System" described by **Knowles** for reading URL-encoded bar code symbols. (2:40-42). The bar code is scanned by a reader to look-up websites of interest. (10:8-11, 40-42). The scanned URL is provided to an Internet browser program so that the information associated with the URL is automatically accessed by the Internet Scanning System. (9:57-61). This process is illustrated, for example, in Figures 1, 2, and 3 of **Knowles**.

In Figure 10, **Knowles** illustrates a web-based package routing, tracking and delivery (RTD) system. (18:29-30). **Knowles** utilizes a URL-encoded bar code symbol (discussed *supra*) printed on a package to access delivery information stored in an RTD server. (19:66 – 20:10). When scanned, the encoded URL is automatically entered into a web-enabled device to access HTML-encoded information on a web-page stored on the RTD Information Server. (19:66 – 20:10). *See also Knowles*, Figures 1, 2, and 3. The scanned information does not include biometric information of an intended recipient, and this deficiency is exasperated by the fact that **Knowles** does not teach or suggest electronically transmitting any encoded information to an

intended recipient of a package. Therefore, even assuming *arguendo* the proposed combination of **Priddy** and **Knowles** was proper, the combination would be missing at least these claimed elements of independent claims 1, 9, and 20 of the present application.

For at least this reason, independent claims 1, 9, and 20 are believed to be in condition for allowance. Dependent claims 2, 7-8, 28-32 (depending from claim 1); 10-11, 14, 19, 33-35 (depending from claim 9); 21-23, 37 (depending from claim 20) must *a fortiori* also be allowable, since they carry with them all the limitations of the independent claims from which they ultimately refer.

The Office alleges that “it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate a two-dimensional bar code for encompassing biometric data, with motivation to improve mail handling through bar code technology.” Office Action, p. 10. However, as already shown, neither **Priddy** nor **Knowles** teaches or suggests electronically transmitting a two-dimensional bar code encoded with biometric information to an intended recipient of an ordered package. Indeed, **Knowles** describes encoding packages with URL addresses for accessing HTML-information on an RTD server. (19:66 – 20:10). **Knowles** does not describe encoding biometric information let alone electronically transmitting any information to an intended recipient of an ordered package. **Priddy** suffers from similar shortcomings in that the information it encodes is “fixed” to the article. **Priddy**, p. 12, lines 9-11.

Section 2143 of the MPEP also requires that the teaching or suggestion to combine references must be found in the prior art, not in the Applicant’s disclosure. The mere fact that a reference may be modified in the direction of the claimed invention does not make the

modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984); Ex parte Clapp, 227 USPQ 972, 973 (Bd. App. 1985); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. App. 1984). In this case, the considerable difference in the disclosures of **Priddy** and **Knowles** suggests that the proposed combination is the result of an impermissible hindsight reconstruction of the pending claims. See *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991) (Suggestion to combine references must be found in the prior art and not based upon Applicant's disclosure). Moreover, the references were not intended to be modified or combined as suggested by the Office. As already indicated, even assuming *arguendo* the proposed combination was proper, it would still be missing elements of independent claims 1, 9, and 20. Namely, neither **Knowles** nor **Priddy** teach or suggest electronically transmitting a two-dimensional bar code encoding biometric information to an intended recipient of ordered package.

Moreover, the Office has failed to show or cite where in **Knowles** or **Priddy** there exists a reasonable expectation of success if the reference teachings are combined, as required by § 2143 of the MPEP. In fact, the Office is silent as to this requirement for making out a *prima facie* case of obviousness. There is no statement or inference in **Knowles** or **Priddy** that would suggest that the references could be successfully combined. The disclosures of these references are considerably different. **Knowles** is directed to an Internet Scanning System for retrieving HTML-encoded information, and **Priddy** describes fixing machine-readable data sets onto articles.

The references simply were not intended to be modified or combined as suggested by the Office. Even if the proposed combination was proper, it would still be missing elements recited

by the independent claims. Furthermore, if there is no motivation to combine found in the references, clearly then, the references cannot show or even implicate a reasonable expectation of success, which is required to make out a *prima facie* case of obviousness.

For this additional reason, independent claims 1, 9, and 20 are believed to be in condition for allowance. Dependent claims 2, 7-8, 28-32 (depending from claim 1); 10-11, 14, 19, 33-35 (depending from claim 9); 21-23, 37 (depending from claim 20) must *a fortiori* also be allowable, since they carry with them all the limitations of the independent claims from which they ultimately refer.

Applicant believes this reply to be fully responsive to all outstanding issues and, in light of the amendments and arguments presented above, Applicant respectfully asserts that the pending claims are allowable. Accordingly, a Notice of Allowance is respectfully solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Houston, Texas, telephone number (713) 934-4079 to discuss the steps necessary for placing the application in condition for allowance.

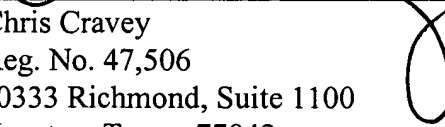
Respectfully submitted,

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6/13/06

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